

Appl. No. : 10/751,614
Filed : January 5, 2004

REMARKS

In response to the Office Action mailed March 11, 2005, claims 21-40 were variously rejected under 35 U.S.C. § 103, it is respectfully maintained that these claims, as amended, be reconsidered. Claims 21, 27, 28 and 36 are the independent claims. Claims 23-24 and 25 depend upon Claim 21. Claims 30-34 depend upon Claim 27, and Claim 35 depends upon Claim 34. Claims 37-40 depend upon Claim 36. Claims 21-40 remain pending claims in subject application.

Change of Position

Once allowed claims and indicated allowed claims from the Examiner's previous Office Action have now been rejected. Applicant respectfully suggests that the Examiner erred based on conclusionary allegations that are not supported by the evidence.

The Examiner's Office Action states:

"... that since the essentially [sic] capability of distinguishing among different types of chips (for example) denominations within the same bet is already present, extending this capability to different classes of chips involves changes only in software." (page 2, third full paragraph of the Office Action)

Applicant respectfully requests that the Examiner provide clear evidence and supporting law on non-patentability based upon "only software changes." Applicants submit that even if the changes are only in software, that software changes, if sufficiently different, are indeed patentable.

More importantly, Applicant respectfully suggests that all subject claims are directed to devices that provide, store, and/or generate class or other type information which is not taught by the cited art. Applicant has amended Claim 21, without adding any new matter, to more clearly recite Applicant's unique and non-obvious features:, namely, "a data field in said memory,

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wherein an identification identifying a first class for the gaming chip is located in said data field. This amendment to Claim 21 makes it clear that the Examiner's position is erroneous, because this "memory located within the transponder" is structure (hardware) and not software. Full support for this amendment is found in Applicant's original specification.

Furthermore, the Examiner states:

"...the need to keep progressive bets in a side pile is largely due to an inability to distinguish among chips, which is not a problem with electronic chips, which can easily be distinguished from one other." (page 2, last full paragraph of the Office Action)

Again, it is respectfully requested that the Examiner provide strict evidence supporting this conclusionary allegation. Applicant respectfully suggests the conclusionary allegation may be based entirely on hindsight after a reading of the present application. As evidence of patentability, it is noted that the Rendleman patent issued November 24, 1992 shows a gaming chip implanted with a programmable identifier means. For a full five years, until the Applicant's invention was filed October 7, 1997, no one in the highly competitive gaming arts, except Applicant, provided a solution to the problem of eliminating side progressive bets. This is solid evidence on non-obviousness as it represents a substantial period of time during which no-one else could solve a problem with a long-standing need.

As further evidence, Applicant respectfully notes that not one of the cited prior art references, nor any combination thereof specifically discuss what is asserted by the Examiner's conclusionary statements.

The discussion pertaining to Rendleman, Busch and French presented later is also incorporated by reference herein as evidence of patentability.

The case law is very clear in forbidding use of hindsight to reconstruct an invention based on teachings from the application undergoing examination. Actual evidence supporting this is

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required. The CAFC stated, In re Bruce Beasley, No. 04-1225 (not citable as precedent, but of public record):

“The record reflects that the examiner and the Board have managed to find motivation for substituting one type of memory for another without providing a citation of any relevant, identifiable source of information justifying such substitution. The statements made by the Examiner, upon which the Board relied, amount to no more than conclusory statements of generalized advantages and convenient assumptions about skilled artisans. At least under the MPEP then in effect, such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on ‘subjective belief and unknown authority.’ In re Lee, 277 F.3d 1338, 1344 (Fed. Cir. 2002). Under such circumstances, with respect to core factual findings, ‘the Board must point to some concrete evidence in the record in support’ of them, rather than relying on its assessment of what is ‘well recognized’ or what a skilled artisan would be ‘well aware.’ In re Zurko, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). ‘To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise.’ Id. at 1386 (citing Baltimore & Ohio R.R. Co. v. Aberdeen & Rockfish R.R. Co., 393 U.S. 87, 91-92 (1968)). Id. at page 10.”

While Beasley is not citable as precedent, it discusses the non-obviousness aspects of memory modification and solid case law is cited therein. Applicant respectfully requests that the Examiner provide evidence or citation to the cited art to support these conclusionary allegations that the claimed invention is obvious.

35 U.S.C. § 103 Claim Rejections

The Examiner’s rejection of Claims 21-40 recognizes that Rendleman fails to show a second class of chip. Nothing in Rendleman teaches or even suggests the intermingling of two classes of chips to obtain two separate bet values. The Examiner relies on Busch for this showing. The Busch patent was filed four years after the Rendleman patent issued. Yet, Busch still recognized the distinctiveness and separateness of progressive chips. As clearly set forth in the Background of Invention section of Busch, progressive side betting is distinctly and differently handled by a casino.

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The Applicant submits that Busch simply affirms the general state of the art, namely, the progressive bets are side bets which are difficult to differentiate from regular bets. Busch teaches that the dealer may manual differentiate the progressive bets or the player may drop the token through a slot, which will detect the passage of the token. Busch, like Rendleman, does not however teach the missing component. In fact, Busch does not concern use of transponders, transceivers, or memory within chips to store class information. The Applicant request that the Examiner consider whether the Busch reference should even be cited due to its focus on subject matter which is different than that claimed. One of ordinary skill in the art reading Busch and Rendleman would not arrive at the claimed subject matter.

In the Office Action the Examiner alleges:

“Capability to distinguish among chips is already present, as evidenced by distinguishing among chips of different denominations. Simply adding to this ability to distinguish among different types of chips involves only software and not hardware changes.” (page 4, first paragraph of Rejection)

Applicant respectfully requests that specific evidence under Beasley be provided to support the Examiner’s allegations. Neither Rendleman nor Busch provide these teachings alone or in combination. The Examiner recognizes that it is not found in Rendleman. Applicant notes that Busch teaches away from this teaching and even the Examiner recognizes the “complex side bets” nature (see the Examiner’s current Office Action page 4, line 4).

The Examiner further alleges:

“As to the limitation of intermingling various classes of chips in the same bet, the examiner notes that the need to keep progressive bets in a side pile is largely due to an inability to distinguish among chips, which in not a problem with electronic chips, which can easily be distinguished from one another. One would have been motivated to intermingle such various chips in the same bet to save table space, which is valuable when there are many players who wish to play.” (page 4, second full paragraph of the current Office Action)

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Hindsight Review

It is maintained that this conclusionary statement is pure hindsight based upon the teachings of the present invention. It is respectfully maintained that until the advent of the present invention, it was not recognized how to combine progressive side bets into a single stack or pile of chips. There is certainly no motivation in Busch to do this nor is there any suggestion or inference for this teaching in Rendleman. To the extent Busch teaches how to make or monitor progressive bets, the teachings are either manually (column 6, lines 29-33, and 33-40) or via a slot with an old style chip counter (column 6, lines 44-51). The Applicant submits that even if Busch and Rendleman are combined, the resulting combination does not teach all the claimed elements.

Busch Is Unrelated Art

In addition, Applicant respectfully suggests that Busch is unrelated art with respect to the teachings of Rendleman. Specifically, Rendleman is directed to the art of making gaming chips having an embedded transponder. Rendleman neither suggests, is motivated, teaches nor renders obvious Applicant's unique and non-obvious features recited in amended independent Claims 21, 27 and 28 and independent Claim 36.

Busch is directed to a roulette table having progressive jackpots and more specifically to a system for playing roulette. Positioning of chips on a jackpot layout is not monitored electronically because there is not data or class information contained within a Busch chip. The inherent structure of the Busch chip prevents it from interacting with a transceiver because it does not contain a transponder, let alone a transponder as claimed. Applicant acknowledges that Busch is not cited for teaching a transponder, but its teaching fall short of that required because it does not teach class designations in transponder equipped chips. Busch, even if combined with Rendleman neither suggests, motivates, teaches nor renders obvious Applicant's unique and non-

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obvious features recited in amended independent Claims 21, 27 and 28 and independent Claim 36.

Applicant has amended independent Claim 21 without the addition of any new matter to more clearly recite Applicant's unique and non-obvious features of a gaming chip for use in a bet in a casino game.

Similarly Applicant has amended independent Claim 27 without the addition of any new matter to more clearly recite Applicant's unique and non-obvious features as claimed.

Finally, Applicant has amended independent Claim 28 without the addition of any new matter to more clearly recite Applicant's unique and non-obvious features as claimed.

Full support for these amendments to independent Claims 21, 27 and 28 is found in the Applicant's original specification. The Applicant has not amended independent Claim 36.

The Examiner also cites the French reference, which represents one skilled in the art well after the Rendleman patent, (filed 1995 and issued 1997), and before the filing of the present application. French does not recognize intermingling two bets into a single stack in a betting area to be read as claimed in the present application. French only recognizes the importance of only a single value from the stack of chips. See column 6, lines 12-16. The requirement of separate bet placement area is very well illustrated in French for a craps table at column 7, lines 48-64. For example, each player has its own separate bet placement area 61, 63, 65 and 67 with an antenna under each area. Each player has the right to bet on don't pass 63, come bet 65, don't come bet 67, etc. French never taught, suggested or even inferred that the separate bet areas could be handled by a single reading area with intermingled chips of the present invention. Because of this, French is solid evidence that the claims of the present invention are unique and non-obviousness.

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In any case, since all the dependent Claims depend upon their respective unique and non-obvious independent Claims, the dependent Claims are also unique and non-obvious. Applicant has now made an earnest attempt to place this application in condition for allowance.

Applicant has not added any new Claims, so no fees are due for any new Claims. If there are any other fees incurred, beyond those provided for by the enclosed check, please deduct them from our Deposit Account No. 502200

SUMMARY

Applicant asserts that Claims 21-40 are in a condition for allowance and respectfully requests a notice as to the same. If any matters remain outstanding, the Examiner is invited to contact the undersigned by telephone.

Dated: 9/12/05

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